

Remarks

1. Summary of the Office Action

In the final office action mailed April 20, 2007, the Examiner maintained rejections of claims 1-3, 5-7, 12, 14-15, and 20-21 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2004/0228292 (Edwards), the rejection of claim 4 under 35 U.S.C. § 103(a) as being allegedly obvious over Edwards in view of U.S. Patent No. 6,501,740 (Sun), and the rejections of claims 8-11, 13, 16-19, and 22-23 under 35 U.S.C. § 103(a) as being allegedly obvious over Edwards in view of U.S. Patent Application Pub. No. 2004/0190489 (Palaez).

2. Status of the Claims

Applicant has amended the claims to emphasize that the instruction from the server to the at least one user station directs the at least one user station to operate in the indicated mode (half-duplex or full-duplex). This amendment is supported by the specification, for instance, at page 10, lines 1-3. Further, Applicant has made other minor corrections in the claims as well.

Pending are still claims 1-19 and 21-23, of which claims 1, 15, and 21 are independent and the remainder are dependent.

3. Response to § 102 Rejections

As indicated above, the Examiner has maintained rejections of each of the independent claims a being allegedly anticipated by Edwards. Applicant submits that these rejections are improper and should be withdrawn, for the reasons set forth in Applicant's last response and further for the reasons discussed below.

According to M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. In this case, Edwards fails to teach all of the elements of any of Applicant's independent claims, either expressly or inherently. Therefore, Edwards fails to anticipate the claims, and the claims should therefore be allowed.

a. Claims as Originally Filed

As discussed in the last response, each independent claim as filed required at a minimum the function of a communication server instructing a user station (or a user station receiving from a communication server an instruction) to operate in a mode selected from the group consisting of half-duplex mode and full-duplex mode. As explained in the last response, Edwards does not disclose this element, either expressly or inherently. Therefore, Edwards did not anticipate any of the independent claims as filed.

At best, Edwards teaches that when a user initiates a dispatch session, the user may tell the system (server) that the user would like to operate in full-duplex, and the system then responsively reserves full-duplex resources and sets up the other parties to the session in full-duplex mode to the extent the other parties support being set up in full-duplex mode. Edwards explains by way of example that reserving resources for full-duplex operation may involve reserving a full-duplex cellular channel. Further, as for setting up the other parties in full-duplex mode, Edwards merely states "the one or more other users who are participating in the dispatch call are placed in the full-duplex mode of operation by the communication system, except for any radios that cannot automatically be put into full-duplex mode (and such radios simply operate in half-duplex mode). See Edwards at paragraphs 0012-0013.

In addition, Edwards teaches that, in an alternative embodiment, "each radio involved in the original dispatch call may receive a distinct audio and/or video alert indicating to the user that the originator of the dispatch call wants to go to full-duplex operation", but that any radio may decide to remain in the half-duplex mode. See Edwards at paragraph 0014.

As explained in Applicant's last response, these teachings of Edwards, like the remainder of Edwards, do not expressly or inherently amount to Applicant's claim feature of a communication server instructing a user station to operate in a mode selected from the group consisting of half-duplex mode and full-duplex mode.

Applicant explained in the last response that the word "instruction" has a well understood meaning, namely: (a) precept, (b) a direction calling for compliance / order, (c) an outline or manual of technical procedure, (d) a code that tells a computer to perform a particular operation, or (e) the action, practice, or profession of teaching. Focusing on the definition of "instruction" as a direction calling for compliance, consistent with the clear intent conveyed by Applicant's specification, Applicant asserted that there is no express or inherent teaching in Edwards of the communication server (or system) providing to a user station an "instruction" that directs the user station to operate in either half-duplex mode or full-duplex mode.

First, Edwards' teaching at paragraphs 0012-0013 of receiving a user's request for full-duplex operation and responsively reserving resources and placing other users into full-duplex mode does not expressly involve the server providing to a user station an instruction that directs the user station to operate in either half-duplex mode or full-duplex mode. Rather, at best, it merely involves placing the other users into full-duplex mode.

Further, that teaching at paragraphs 0012-0013 does not inherently involve the server providing to a user station an instruction that directs the user station to operate in either half-duplex mode or full-duplex mode, since providing such an instruction to a user terminal does not necessarily follow from the disclosure of Edwards, as would be required to establish inherence under M.P.E.P. § 2131.01(III). It is entirely plausible within the disclosure of Edwards that the dispatch system would place each user station into full-duplex mode by simply placing a cellular telephone call to each user station, whereas, if a given user station is not capable of engaging in full-duplex communication, the dispatch system could simply initiate conventional iDen half-duplex communication to the user station. This would achieve what Edwards teaches in paragraphs 0012-0013 without involving a server providing to a user station an instruction that directs the user station to operate in either half-duplex mode or full-duplex mode. Therefore, the claim function is not inherent in these paragraphs of Edwards.

Still further, Edwards' teaching at paragraph 0014 of each radio involved in the dispatch call receiving an audio or video alert indicating to the user that the originator of the dispatch call wants to go to full-duplex operation also fails to expressly involve a communication server providing a user station with an instruction that directs the user station to operate in either half-duplex mode or full-duplex mode. Rather, at best, it merely involves notifying the various user stations that the originator wants to use full-duplex mode. Such notification is clearly not an "instruction" as that is well understood and clearly used Applicant's specification and claims. In fact, the highly permissive non-instructional nature of this "alert" is evident from Edwards' teaching in paragraph 0014 that a user can simply operate in half-duplex mode after receiving the alert indicating that the originator wishes to operate in full-duplex mode.

Yet further, this teaching in paragraph 0014 does not inherently involve the server providing to a user station an instruction that directs the user station to operate in either half-duplex mode or full-duplex mode, since providing such an instruction to a user terminal does not necessarily follow from the disclosure in this paragraph. It is clearly plausible that the dispatch system could notify a user/radio that the originator wishes to operate in full-duplex mode as described in Edwards, without the system providing the user/radio with an "instruction" directing the user/radio to operate in that mode.

Additionally, Applicant explained that there is no disclosure in Edwards to achieve the invention recited by Applicant's independent claims as filed.

Because Edwards fails to teach (expressly or inherently) the invention recited by any of Applicant's independent claims, Edwards did not anticipate the independent claims as filed, and consequently Edwards also did not anticipate any of the dependent claims.

b. Reply to Examiner's "Response to Arguments"

In the "Response to Arguments" section of the final office action, the Examiner stated: "Examiner posits that it is not unreasonable to correlate the teachings of Edwards, specifically, having the system control (server) assign the necessary system resources to support the full-duplex call to a mobile station, as the system control needs to 'instruct' the mobile station on the amount of resources to use for a full-duplex call." (See final office action, at page 9, lines 9-12.)

This assumption by the Examiner, however, does not rebut Applicant's point that Edwards fails to expressly or inherently describe at least the claim function of the server providing the user station with an instruction directing the user station to operate in a full-duplex mode or half-duplex mode. The fact that the system in Edwards assigns resources to

support a full-duplex call (as set forth in Edwards at paragraph 0018, cited by the Examiner) does not mean that the system instructs a user station to operate in a full-duplex mode.

At a minimum, Edwards' teaching of that function does not constitute an express teaching of the claim function at issue, as it says nothing on its face about providing an instruction to the user terminal directing the user terminal to operate in full-duplex mode or in half-duplex mode. Edwards' teaching of assigning resources to support a full-duplex call clearly is not an express teaching of sending to a user station an instruction to operate in full-duplex mode or in half-duplex mode.

Furthermore, this teaching of Edwards also fails to constitute an inherent teaching of the claim function at issue, since Edwards' teaching of the system assigning resources to support a full-duplex call does not *necessarily* include the claim function of sending to a user station an instruction to operate in full-duplex mode or in half-duplex mode. Indeed, the system "assigning" resources for a call does not necessarily say anything about the system providing an instruction to a user station to operate in a full-duplex mode or a half-duplex mode. The resource assignment can plausibly be a resource assignment within the radio access network or an assignment of a channel that could equally well be used for half-duplex communication (e.g., a double-channel that could support half-duplex communication and could just as well support full-duplex communication). And even if the assignment involves communication with the user station, that communication does not necessarily involve instructing the user station to operate in full-duplex mode or in half-duplex mode.

The Examiner's assumption that it is "not unreasonable to correlate the teaching of Edwards" in the manner posited by the Examiner in the final office action thus does not make

up for the failure of Edwards to teach Applicant's combination of claim elements expressly or inherently as is required by the M.P.E.P.

In addition, also in the "Response to Arguments" section, the Examiner disputed Applicant's argument regarding the meaning of the term "instruction." In particular, the Examiner argued that the term "instruction" is also understood to mean "imparted knowledge or an imparted or acquired item of knowledge." Applicant obviously agrees that this is an accepted alternative definition of the word "instruction." However, the alternative definition does not make sense in the context of Applicant's independent claims as filed.

Where Applicant's claims recited "the communication server instructing at least one of the user stations to operate in a mode. . .", it would be illogical to conclude that "instructing" means "imparted knowledge.". In fact, the claim recites the gerund-form verb of "instructing", rather than the noun of "instruction," which is the term that means "imparted knowledge". "Instructing" does not mean "imparted knowledge".

Furthermore, where Applicant's claims recited "a user station receiving from a communication server an instruction indicating whether the user station should operate in a half-duplex mode or a full-duplex mode", it would also be illogical to conclude that "instruction" means "imparted knowledge", since the claim language itself recited that the instruction indicates whether the user station should operate in half-duplex mode or in full-duplex mode. Such claim language would not be understood to mean that knowledge of the mode was being imparted to the user station; it would be read to mean that the server was telling the user station what mode the user station should use, i.e., as a directive to the user station.

Therefore, contrary to the Examiner's conclusion, Edwards' teaching of a user/radio receiving an alert indicating that the originator of the dispatch call wishes to go to a full-duplex operation does not constitute the user/radio receiving an instruction indicating whether the user/radio should operate in a half-duplex mode or a full-duplex mode as recited in Applicant's claims. Rather, it merely constitutes receiving "imparted knowledge" that the originator has that desire. As explained above, the alert is not an instruction that indicates to the recipient user station that the user station should operate in a full-duplex mode or in a half-duplex mode, as Edwards teaches that a user may simply operate in half-duplex mode after receiving an alert indicating that the originator wishes to operate in full-duplex mode.

c. Allowability of Claims as Amended

Although Applicant believes the claims as originally written clearly distinguished over Edwards, Applicant has amended the claims to leave no question about the meaning of the term "instruction" or "instructing." The claims as now amended expressly recite that the server *directs* the user station to operate in a half-duplex mode or in a full-duplex mode. In particular, claim 1 now recites ". . .the communication server directing at least one of the user stations to operate in a mode" Claim 15 now recites ". . .a user station receiving from a communication server an instruction directing the user station to operate in a mode" And claim 21 now recites ". . . to receive from the communication sever an instruction directing the user station to operate in a mode"

As amended, the Examiner's proposed alternative definition of the word "instruction" is necessarily inapplicable. Further, for all of the other reasons discussed above as well, Applicant submits that each of the independent claims patentably distinguishes over Edwards. Consequently Applicant submits that each of the independent claims is allowable.

Furthermore, without conceding the Examiner's other assertions, Applicant submits that each of the dependent claims is allowable for at least the reason that the dependent claims depend from the allowable independent claims.

4. Conclusion

For the foregoing reasons, Applicant respectfully requests favorable reconsideration and allowance of all of the pending claims.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

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